REMARKS

Claims 2,3, 5, 15, 17-18, 25-26, 29-30, 33-34, 37 and 39-40 remain pending in the application.

Claim Amendments

By this amendment, claims 9, 10, 12, 20, 23, 27, 28, 31, 32, 35, 36, 38, 41 and 42 are cancelled. Claims 2, 3, and 37 are amended. Support for the amendment of the claims resides at page 14, lines 19-24 of the specification. No new matter is added by this amendment.

Allowable Subject Matter

Applicants acknowledge with thanks the indication of allowable subject matter of claims 5, 17, 26, 34 and 40. In view of the above amendments and the following remarks, it is believed that all other pending claims should be found to be allowable.

Objection to Claims

Various of the pending claims stand objected to as being substantial duplicates. In response, multiple pending claims are cancelled in order to overcome this objection. Applicants accordingly believe that the pending claims fully comply with 37 CFR 1.75, and the objection should be withdrawn.

Rejection under 35 USC 102(e) over Verschueren et al

Claims 2-3, 9-10, 15, 18, 20, 23, 25, 27, 29-33, 35, 37-39, and 41 stand rejected under 35 USC 102(e) as being anticipated by Verschueren et al. This rejection respectfully is traversed to the extent deemed to apply to the claims as amended.

In response, claims 2, 3 and 37 are amended as discussed below, and claims 9-10, 20, 23, 27, 31-32, 35, 38 and 41 cancelled. Claims 2-3, 15, 18, 25, 29, 30, 33, 37, and 39 remain under rejection.

Verschueren et al is directed to a heat-sensitive material for making lithographic printing plates having on a lithographic support an image-forming layer including a hydrophilic binder, a crosslinking agent for the hydrophilic binder, *metal oxide particles with a mean diameter of at least 100 nm*, and dispersed hydrophobic thermoplastic polymer particles.

The reference teaches that particles of titanium dioxide or other metal oxide are incorporated in the heat-sensitive layer. Such particles are present in an amount of from 50 to 95% by weight based on the heat-sensitive layer, and preferably from 60 to 90% by weight. The Examiner's attention is directed to column 3, line 60 to column 4, line 4 of the reference in this regard.

The examples of the reference confirm that titanium oxide is present in an amount of at least 48% by weight (Example 1:

53.4%; Example 2: 48.3%; Example 3: 55.7%; Example 4: 54.5%; and Example 5: 52.1%).

By contrast, applicants' claimed photosensitive composition does not contain metal oxide particles as an essential component.

In an attempt to more clearly distinguish over the reference, claims 2, 3 and 37 are amended to state that the recited photosensitive composition "consists essentially of" the recited components (which do not include metal oxide particles).

The claimed invention thus cannot be said to be anticipated by the cited reference. The rejection is without basis and should be withdrawn.

Rejection under 35 USC 102(e) over Leon et al

Claims 2, 9, 15, 18, 20, 23, and 29-32 stand rejected under 35 USC 102(e) as being anticipated by Leon et al. This rejection respectfully is traversed to the extent deemed to apply to the claims as amended.

In response, claims 9, 20, 23, and 31-32 are cancelled. Claims 2, 15, 18, 29, and 30 remain under rejection.

Leon discloses an imaging member comprising a support having a hydrophilic imaging layer comprised of a hydrophilic heat-sensitive cross-linked vinyl polymer which is thermally switchable. The polymer comprises repeating units of

organoonium groups wherein post-imaging wet processing of the imaging member is not required (see claim 1).

However, Leon fails to teach or disclose the present invention having a phase separation structure comprised of a hydrophilic polymer phase and a hydrophobic polymer phase, or which comprises a hydrophobic polymer before irradiation with a light.

Leon is similar to the claimed invention only with respect to the aspect that exposed areas are rendered more oleophilic than the unexposed areas by heat provided by the imagewise exposing (see column 3, lines 24-26). However, the reference teaches that the hydrophilic resin itself in the photosensitive layer is rendered oleophilic with irradiation of light. Moreover, Leon does not make reference to the presence of a hydrophobic polymer.

Applicants note the Examiner's statement at pages 6 and 10 of the Official Action that "it is not clear if the hydrophobic phase of the present invention contains an actual polymer". The Examiner apparently is of the view that the reference does not teach the presence of a hydrophobic *polymer per se* (consistent with applicants' argument) - see page 10 of the Official Action in this regard.

In response, applicants submit that the only rational interpretation of the claim 2 limitation "hydrophobic polymer

phase" is that a hydrophobic *polymer* is actually present. If it is indeed the Examiner's view that the reference does not teach the presence of a hydrophobic *polymer*, then it is clear, based on a reading of claim 2, that the reference cannot be said to anticipate the claimed invention.

The rejection is thus without basis and should be withdrawn.

Rejection under 35 USC 102(e) over Van Damme et al

Claims 2, 9, 15, 18, 20, 23, and 29-32 stand rejected under 35 USC 102(e) as being anticipated by Van Damme et al. This rejection respectfully is traversed to the extent deemed to apply to the claims as amended.

In response, claims 9, 20, 23, and 31-32 are cancelled. Claims 2, 15, 18, 29, and 30 remain under rejection.

Van Damme et al is directed to a heat-sensitive imaging element for providing a lithographic printing plate. The element is comprised of a support and as a top layer a heat switchable image forming layer comprising a hardened hydrophilic binder and a heat switchable polymer wherein the top layer or a layer adjacent to the top layer comprises a compound capable of converting light into heat.

Van Damme teaches that the heat switchable polymer itself is converted to being oleophilic with heat.

Van Damme fails to teach or suggest the present invention having a phase separation structure comprised of a hydrophilic polymer phase and a hydrophobic polymer phase, or which comprises a hydrophobic polymer before irradiation with a light.

The reference discloses only that a portion of the heat switchable polymer, not an island phase of the island-sea structure of the present invention, is converted to being oleophilic with heat.

The heat switchable polymer itself is converted to being oleophilic with heat, so that there is no need for the presence of the hydrophobic polymer phase of the present invention.

As the reference is silent with respect to the presence of a hydrophobic polymer, the claimed invention cannot be anticipated in the manner asserted by the Examiner.

Applicants note the Examiner's statement at pages 8 and 10 of the Official Action that "it is not clear if the hydrophobic phase of the present invention contains an actual polymer". The Examiner apparently is of the view that the reference does not teach the presence of a hydrophobic *polymer per se* (consistent with applicants' argument) - see page 10 of the Official Action in this regard.

In response, applicants submit that the only rational interpretation of the claim 2 limitation "hydrophobic polymer phase" is that a hydrophobic *polymer* is actually present. If it

is indeed the Examiner's view that the reference does not teach the presence of a hydrophobic *polymer*, then it is clear, based on a reading of claim 2, that the reference cannot be said to anticipate the claimed invention.

The rejection is thus without basis and should be withdrawn.

In view of the above, the application is believed to be in condition for allowance and an early indication of same is earnestly solicited.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Very truly yours,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By _____

Marc S. Weiner
Reg. No. 32,181
P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

MSW/JWH/sh
1155-0264P